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Paper No. 5

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In re Application of
Kleinpeter, et al.
Application No. 09/693,393
Filed: October 20, 2000
Attorney Docket No.: AUDIO1100-1
For: SYSTEM AND METHOD FOR ENABLING:
FILE TRANSFERS EXECUTED IN A
NETWORK ENVIRONMENT BY A SOFTWARE
PROGRAM

**OFFICE OF PETITIONS
A/C PATENTS
ON PETITION**

This is a decision on the petition under 37 CFR 1.183, filed March 14, 2001, requesting that the above-identified application be accorded a filing date of October 19, 2000 instead of October 20, 2000. Petitioner seeks a waiver of the requirements of 37 CFR 1.10 to prevent loss priority rights.

Petitioner maintains that the above-identified application was prepared for filing on October 19, 2000 by attorney Armando Pastrana; that Janice Pampell completed and signed the Certificate of Mailing by Express Mail contained in the application papers; that Janice Pampell sealed the Express Mail envelope containing the application papers; that the Express Mail envelope containing the application papers was then delivered to an independent copying and mail contractor, IKON; and that according to IKON, the Express Mail envelope was then picked up by Corporate, Financial and Industrial Delivery, a courier service, with instructions for immediate delivery to the USPS.

Petitioner states that the employee of the courier service assigned to deliver the Express Mail envelope containing the application papers forgot the package in his car and neglected to deliver the Express Mail envelope to the USPS until the next day, October 20, 2000.

A suspension of the rules is provided under 37 CFR 1.183 wherein it states that "in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed."

The filing date of an application for patent is defined in 35 U.S.C. 111(a) as "the date on which the specification and any required drawing are received in the Patent and Trademark Office" (emphasis supplied). However, 35 U.S.C. 21(a) provides that:

[t]he Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the

United States Postal Service but for postal service interruptions or emergencies designated by the Director.

Thus, under the provisions of 35 U.S.C. 21(a), an application may also be accorded the date on which it was deposited with the United States Postal Service as the application filing date.

In this case, the application was neither "received in the Patent and Trademark Office" nor "deposited with the United States Postal Service" on October 19, 2000. Further, the requirement in 37 CFR 1.10(a) that the paper or fee be "deposited with the USPS" is a requirement of the statute (35 U.S.C. 21(a)) and, thus, may not be waived or suspended under 37 CFR 1.183.

Assuming, arguendo, that the requirements of 37 CFR 1.10(a) could be waived or suspended, the circumstances surrounding petitioner's failure to deposit the application papers via Express Mail service on October 19, 2000 are not deemed extraordinary such that a waiver or a suspension of the requirements of 37 CFR 1.10 is warranted.

While it is acknowledged that if 37 CFR 1.10 is not waived, petitioner's application for patent will lose its right of priority under 35 USC 119, it is not enough to show that a great loss of rights will occur to justify suspension or waiver of the rules under 37 CFR 1.183 simply because the failure to comply with the requirements of 37 CFR 1.10 was an avoidable oversight that could have been prevented by the exercise of due care or diligence and hence not an extraordinary event within the meaning of 37 CFR 1.183. See, Nitto Chemical Industry Co., Ltd. V. Comer, 37 USPQ2d 1778 (1994).

Petitioner elected to deposit the Express Mail package not with the USPS but instead with third parties the conduct of which petitioner could in no way predict and guarantee. Notably, both the Certificate of Express Mailing and the Express Mail label itself are signed by Janice Pampell. Clearly Janice Pampell was not charged with delivering the Express Mail package containing the application papers to the USPS, and did not in fact undertake to deliver the package. As a result, Janice Pampell could not certify that the Express Mail package containing the application papers would be deposited with the USPS on the desired "date-in."

Depositing the application papers with not one but two services other than the USPS resulted in an oversight that could have been prevented by the exercise of ordinary care or diligence. Petitioner elected to depend on third parties to ensure that the Express Mail package was delivered to the USPS on October 19, 2000. Petitioner did not require third parties to return a date-stamped Express Mail receipt on the day of deposit as added assurance that the Express Mail package containing the application papers was timely received by the USPS on the desired "date-in." As a result of reliance upon third parties to deliver the Express Mail package containing the application papers, the applicant could not guarantee that the package would in fact be delivered on the desired "date-in."

Moreover, no extraordinary circumstance has been shown to have occurred to have precluded petitioner from depositing the correspondence directly with an employee of the USPS to ensure

receipt a legible copy of the Express Mail label with the desired "date-in" clearly marked. "Persons dealing *indirectly* with the employees of the USPS ... do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked." 37 CFR 1.10(b) (emphasis added). Petitioner's failure to obtain an "Express Mail" receipt with the desired date-in is clearly an omission that could have been avoided with the exercise of due care.

Petitioner's failure to deposit the application papers on the desired "date-in" arose as a result of reliance on third parties. Such reliance is not an extraordinary occurrence warranting a suspension or waiver of the rules.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTH** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency decision.

Further correspondence with respect to this matter should be addressed as follows:

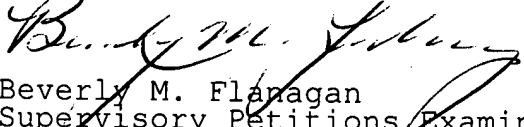
By mail: Commissioner for Patents
Box DAC
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By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
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The application is being returned to Technology Center 2100 for examination in due course with the presently accorded filing date of October 20, 2000.

Telephone inquiries related to this decision may be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy